

REMARKS/ARGUMENTS

Reconsideration and allowance of the present application based on the following remarks are respectfully requested. Claims 5, 15, 19, and 22 have been amended. Support for the amendments may be found throughout the specification. No new matter has been added as a consequence of these amendments.

Claims 3-7, 9-10, 15, 19, 21, and 22-23¹ stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 6,462,001 ("Kenbeek '001") in view of U.S. Patent 3,717,672 ("McGee"). Claim 11 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Kenbeek '001 in view of McGee and in further view of U.S. Patent 4,479,883 ("Shaub '883"), or in the alternative over Kenbeek '001 in view of McGee and in further view of U.S. Patent 4,293,432 ("Papay") and U.S. Patent 4,783,274 ("Jokinen"). Claim 21 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Kenbeek '001 in view of McGee and in further view of U.S. Patent 3,202,701 ("Young").

Applicants submit that the pending claims, as amended, are directed towards a method of reducing wear in an automotive engine by using an automotive engine oil comprising, *inter alia*, a specified ester having a kinematic viscosity at 100 °C ranging from 1500 to 5000 mm²/s. Unlike the ester of the pending claims, the ester discussed in Kenbeek '001 have a kinematic viscosity at 100 °C ranging from 30 to 1000 cSt (*i.e.*, mm²/s) (*see* Kenbeek '001 at col. 3, lines 8-10). Accordingly, contrary to the assertion detailed on page 6 of the present Official Action, the specified ester of the pending claims are not obvious from that of Kenbeek '001.

Moreover, none of the cited references, alone or in combination with the other cited references, cure the above-noted deficiencies of Kenbeek '001. Therefore, Applicants submit that the Examiner has failed to present a *prima facie* case of obviousness and that the pending claims are believed to be patentable over the cited references.

Even assuming *arguendo* that a *prima facie* case of obviousness were presented, Applicants direct the Examiner's attention to the unexpected results achieved by the pending claims. Specifically, the below Table (Table 1 reproduced from the instant application), compares three identical engine oil compositions, differing only in the antiwear additive system utilized (the claimed ester ("Claimed"), a ZDDP comparative antiwear additive system ("Comparative A") or no antiwear additive system ("Comparative B")):

¹ Applicants note that claims 22-23 were not specifically listed in any of the rejection headings, but were discussed in the body of the text.

TABLE

	Antiwear Additive System		
	Claimed	Comparative A	Comparative B
Cam nose wear (μm)	4	11.9	55.7
Cam lobe wear (μm)	24.1	56.4	393.2
Viscosity unused oil (at 40°C in mm^2/s)	68	70.8	66.4
Viscosity used oil (at 40°C in mm^2/s)	52.9	52.4	52.8
Zn content (ppm)	533	>900	7
Fe content (ppm)	10	58	431
Cu content (ppm)	1	3	1

The Example falling within the pending claims (*i.e.*, the "Claimed" system) has achieved the unexpected results of having significantly *reduced* the cam lobe and cam nose wear, *while* having much lower phosphorous, sulfur, and metal content. Applicants submit that neither Kenbeek 001' nor any of the other cited references, alone or in combination, suggest the unexpected results achieved by the pending claims. Accordingly, it is submitted that the pending claims are believed to be patentable over the cited references.

Therefore, it is respectfully submitted that the present application is in a condition for allowance and a Notice to that effect is earnestly solicited.

Should any issues remain unresolved, the Examiner is encouraged to contact the undersigned attorney for Applicants at the telephone number indicated below in order to expeditiously resolve any remaining issues.

Respectfully submitted,

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